

REMARKS

Claims 1-27 are all the claims pending in the application.

Formal matters

Applicant thanks the Examiner for accepting the drawings as filed on March 7, 2002 and for acknowledging claim to foreign priority and receipt of a certified copy of the priority document. Applicant also thanks the Examiner for reviewing and initialing the documents in the information disclosure statement submitted on March 7, 2002.

Claim rejections – 35 U.S.C. § 112

Claims 10, 22, and 7 and 19 stand rejected under 35 U.S.C. § 112, second paragraph. Applicant has amended the claims and respectfully requests the Examiner to withdraw the rejection.

Claim rejections – 35 U.S.C. § 101

Claim 26 stands rejected under 35 U.S.C. § 101. Applicant has amended claim 26 and respectfully requests the Examiner to withdraw the rejection.

Claim rejections – 35 U.S.C. § 102

Claims 1, 2, 4, 8, 12-14, 16, 18, 20, and 24 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,671,454 to Kaneko. Applicant respectfully traverses this rejection.

For example, claim 1 recites the feature of a compression setting storing unit, which stores a re-compression condition which is a condition of starting a compression and an encoding method used in the compression. The Examiner maintains that this feature is met by Kaneko at col. 13, line 60 to col. 14, line 25. However, Applicant respectfully disagrees with the Examiner's position. While Kaneko discusses re-compressing data, in general, at the cited portion, Kaneko does not disclose or otherwise teach compression settings, as set forth by the claim. For example, Kaneko does not contain any teachings of encoding methods, much less an encoding method being stored. Therefore, claim 1 is patentable over Kaneko for at least these reasons.

Independent claim 13 recites features similar to claim 1, and therefore claim 13 is patentable over Kaneko for the same reasons. The remaining claims are patentable based on their respective dependencies.

Claim rejections – 35 U.S.C. § 103

Claims 3, 5, 15, and 17 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kaneko in view of U.S. Patent No. 5,410,344 to Graves. Claims 9, 21, 25, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kaneko in view of U.S. Patent Application Publication No. 2002/0104094 to Alexander. Claims 11 and 23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kaneko in view of U.S. Patent No. 6,160,844 to Wilkinson.

Under 35 U.S.C. § 103(c), subject matter developed by another person, which qualifies as prior art only under one of § 102(e), (f), and (g), shall not preclude patentability under § 103 where the subject matter and the claimed invention were, at the time the claimed invention was made, subject to an obligation of assignment to the same person. Applicant respectfully notes that Kaneko qualifies as prior art under § 102(e). Moreover, both the primary reference to Kaneko and the instant application are assigned to NEC Corporation. U.S. Patent and Trademark Office assignment records show that the assignment in Kaneko was recorded on February 11, 2000 at Reel/Frame 010576/0872. Therefore, Applicant respectfully submits that at the time the claimed invention was made, the subject matter of Kaneko and the claimed invention were subject to an assignment to the same person. As such, pursuant to 35 U.S.C. § 103(c), the subject matter of Kaneko shall not preclude the patentability of the claimed invention.

Since none of the remaining references of record, alone or in combination, teach all the features of the claims, the claims are patentable, and thus Applicant respectfully requests the Examiner to withdraw the rejections.

With further regard to the secondary reference to Alexander, Applicant respectfully notes that Alexander is not prior art to the present application. The present application claims priority from Japanese Patent Application No. 2001-63742, which was filed on March 7, 2001. Alexander was filed on December 3, 2001, after the filing date of the Japanese priority document for the present application. Should the Examiner apply Alexander in a subsequent Office Action, Applicant will submit a certified English translation of the JP 2001-63742 priority document, thereby removing Alexander as a prior art reference.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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